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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,523	04/18/2001	Claude Debroche	34213-071556.0172	8187
27799	7590	05/04/2004	EXAMINER	
COHEN, PONTANI, LIEBERMAN & PAVANE 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176			KNABLE, GEOFFREY L	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/837,523

**Applicant(s)**

DEBROCHE, CLAUDE

**Examiner**

Geoffrey L. Knable

**Art Unit**

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9,12,13,15 and 16 is/are allowed.
- 6) ☒ Claim(s) 10,11,14 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2-24-2004 has been entered.
2. Claims 10, 11, 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

New claims 10 and 11 define that the knife-supporting disk rotates at a speed that is greater than or at least two times greater than the rotating speed of the input shaft. Although it would be agreed that the knife supporting disk in the described embodiments is clearly rotating faster than the input shaft, the invention as originally described never appears to describe or characterize actual values for the relationship between these speeds and as such, newly defining or describing that one is greater than (or two times greater than) the other is not considered to have been described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to be new matter. Note for example that new claim 10 characterizes the invention as inclusive of any apparatus configuration where the disc

speed is greater (even by a very small amount) than the input shaft. However, insofar as the original disclosure does not characterize any specific relationship between these speeds, this new characterization of the invention describes embodiments (e.g. one speed 1.1 times the other) that are not considered to be supported by the original disclosure. It is noted that the original disclosure does describe examples where the knife returns to the cutoff point every two or three (or more) turns of the planet carrier (47) and an examination of for example fig. 3 would indicate that the knife disc is rotating five times for two rotations of the planet carrier and thus the knife disc is rotating 2.5 times faster than the planet carrier while in fig. 4, the disc is rotating seven times for three rotations of the carrier disc (47), i.e. a relative speed of 2.33 times. A relative speed range of greater than (or greater than two times) is however not described by these examples. Characterizing the invention as described in new claims 10 and 11 is thus considered to be unsupported and therefore new matter.

New claims 18 and 19 are directed to and only supported by the figs. 5-6 embodiment. However, insofar as claim 9 (from which these claims depend) is not considered to be consistent with or generic to the figs. 5-6 embodiment, the presentation of new claims 18 and 19, that are directed and limited to the figs. 5-6 embodiment but are also dependent upon claim 9, is considered to newly describe the invention in a manner that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to be new matter. In particular, claim 9 defines that the "knife moves along a closed path

which passes proximate the cutoff point but passes through the cutoff point only every  $n$  passes of the knife proximate the cutoff point, wherein  $n$  is greater than or equal to two". This is considered to be consistent with the original description of the figs. 2-4 embodiment (as well as original claim 2), in which the knife is described such that "FIG. 3 illustrates the path of the knife 42 when it returns to the cutoff point every two turns of the planet carrier 47, and FIG. 4 illustrates the path of the knife 42 when it returns to the cutoff point every three turns of the planet carrier 47." Thus, a pass of the knife is defined by rotation of the carrier 47. In the figs. 5-6 embodiment, however, it is first noted that there is no explicit description of the claim requirement that the "knife moves along a closed path which passes proximate the cutoff point but passes through the cutoff point only every  $n$  passes of the knife proximate the cutoff point, wherein  $n$  is greater than or equal to two". Rather, the movements for this embodiment are described as

"The knife 142 is continuously driven at high speed. It is in inactive position in FIG. 6 and, at the right time, advances to the cord 3 in order to cut it (see FIG. 5). The cutting device 14 is then so set up that the knife 142 describes a path which crosses the reinforcement at said cutoff point, when the outwardly extended part 149 of the cam is engaged by the stud 136."

There is thus no description of the knife passing the cutoff point every  $n$  passes,  $n$  being greater than or equal to 2. That is, unlike the figs. 2-4 embodiment, this embodiment is not described in any manner relative to the number of passes, etc. As such, claim 9 is not considered to be generic to the figs. 5-6 embodiment and thus again new claims 18 and 19, that are directed and limited to the figs. 5-6 embodiment but are also dependent upon claim 9, are considered to newly describe the invention in a

manner that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to be new matter.

3. Claims 14 and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, lines 2-3, the reference to an "application roller bearing, the application roller bearing being driven by a movement of a support..." is indefinite and confusing and seems to be incorrect in defining that the "bearing" applies the reinforcement. Clarification is required but it seems that the intent was to define an "application roller bearing *on the support*, the application roller being driven...", i.e. substantially as defined in original claim 4.

New claims 17 and 18 refer to "n" revolutions of the planet carrier and "n" passes of the knife. Insofar as claim 9 also refers to a variable "n" and in particular provides specific constraints on its value, it is not clear how or whether the "n" referred to in claims 17 and 18 is the same as the "n" in claim 9 and thereby subject to the same constraints. Clarification is required.


4. Claims 9, 12, 13, 15 and 16 are allowed and claims 14 and 17 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

These claims are allowed/allowable over the closest prior art for the reasons advanced by applicant in the 2-24-04 response.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Geoffrey L. Knable  
Primary Examiner  
Art Unit 1733

G. Knable  
April 28, 2004